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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/971,960	11/17/1997	HANS ULRICH STILZ	026083/0138	4995

26633 7590 11/25/2002

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EXAMINER

QAZI, ŞABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/971,960

Applicant(s)

STILZ ET AL.

Examiner

Sabiha Naim Qazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 21-24 and 39-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-24 and 29-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 21-24 and 39-103 are pending.

Claims 21-24 and 39-103 are rejected.

No claim is allowed.

Applicant's amendments and response filed in paper no. 35 and terminal disclaimer in paper no. 37 and 38, dated 10/11/02 is hereby acknowledged. Amendments are entered. Rejections of claims 21-24 and 39-103 under double patenting over claims 11-15 of U. S. Patent No. 6034,238; claims 1-17 of US Patent 5,998,447 are withdrawn because terminal disclaimer has been filed by Applicants. Double patenting rejection over 09/405,843 and US Patent 6,218,415 is maintained. Rejection over 09/405,843 is maintained because Applicants in their response are silent regarding this application. Rejection over '415 is maintained because the amendments in claims are actually the disclaimed language in '415. During personal interview with Applicant's representatives Examiner had requested to disclose the prior art responsible for disclaiming certain X and X1. (See interview summary). Since no reasonable response has been received rejection is maintained.

Applicant's arguments are found persuasive therefore; DP rejection over a new application 09/995,631 is maintained and will be withdrawn when this instant application would be in the condition for allowance. The search was limited to elected invention and exemplified compounds in the specification. Since there is no structural core is in the formula as claimed, a complete search for each substituent was not possible. (If group restriction would have been made more than hundred groups could be possibly made). Applicant must disclose all the information related to this application, which includes any co-pending applications and/or Patents.

Double Patenting: Claims 21-24 and 39-103 stand rejected under the judicially created doctrine of double patenting over claims 7 and 8 of US 6,218,415, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Claims 21-24 and 39-103 are provisionally rejected under the judicially created doctrine of double patenting over claims 25-28 of co pending Application No. 09/995,631. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced co pending application and would be covered by any patent granted on that co pending application since the referenced co pending application and the instant application are claiming common subject matter, as follows. Claims 25-28 are drawn to same method of use as instantly claimed, therefore, they are obvious. The method of treatment as instantly claimed are obvious/overlap the claims of the said co pending application. The method of treatment as instantly claimed are obvious/overlap the claims of the said US Patents. Claims of these patents are drawn to inhibitors of the adhesion and migration of leucocytes and/or antagonists of the adhesion receptor VLA-4 that belongs to the group of integrins. The integrin includes the fibrinogen receptor on platelet, which interacts especially with RGD sequence of fibrinogen, or the vitronectin receptor or of osteopontin.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Naim Qazi whose telephone number is 703-305-3910. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-

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308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

November 22, 2002



SABIHA QAZI, PH.D
PRIMARY EXAMINER